

### **REMARKS**

With this response, claims 32-35 are pending. Claims 32 and 35 have been amended without prejudice or disclaimer by way of the present amendment. No new matter enters by this amendment. Support for the foregoing amendment can be found throughout the specification and the claims as originally filed.

#### **I. Information Disclosure Statement**

Applicants thank the Examiner for the Examiner-initialed copy of the PTO-1449 forms.

#### **II. Objections to the Specification**

With this response, the status of the applications in the first paragraph of the specification is updated, and the title has been amended. In light of this, Applicants believe this objection is moot and withdrawal of this objection is requested.

#### **III. Rejection under 35 U.S.C. § 112, Second Paragraph, Definiteness**

Claims 32 and 35 stand rejected under 35 U.S.C. § 112 as allegedly indefinite in that they recite “polypeptide consisting of OCIF protein” and “polypeptide comprising OCIF protein”. *Office Action* at page 2. Applicants accept and thank the Examiner for his suggestion for claims 32 and 35. Applicants have amended these claims to conform to the Examiner’s suggestion.

Claims 32 and 35 also stand rejected under 35 U.S.C. § 112 as allegedly lacking metes and bounds as to what structure is associated with “OCIF protein”. *Id.* at page 3. This rejection is respectfully traversed. It is submitted that one of skill in the art would be apprised of the scope of the present claims.

More particularly, the Examiner is directed to, for example, in the abstract, as well as where the protein is identified, for example, Examples 3-5. The law merely requires that “the claims read in light of the specification reasonably apprise those skilled in the art of the scope ....” *Credle v. Bond*, 25 F.3d 1566, 1576, 30 U.S.P.Q.2d 1911, 1919 (Fed. Cir. 1994) (emphasis added). The degree of precision need only be “as accurate as the subject matter permits.” See *Orthokinectics, Inc. v. Safety Travel Chains, Inc.* 806 F.2d 1565, 1 U.S.P.Q.2d 1081, 1088 (Fed. Cir. 1986). Accordingly, the term “OCIF protein” is not impermissibly indefinite. One of skill in the art will readily appreciate that “OCIF protein” refers to a compound that is produced by

human lung fibroblast cells and inhibits osteoclast differentiation and/or maturation having a molecular weight of about 60 kD and about 120 kD under non-reducing conditions and about 60 kD under reducing conditions on SDS-polyacrylamide gel electrophoresis.

#### **IV. Rejection under Double Patenting**

Claims 33 and 34 stand rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 6,855,808 (“the ‘808 patent”). *Office Action* at page 3. Applicants respectfully disagree with the Examiner’s position. “A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.” *Manual of Patent Examining Procedure* (“MPEP”) §804 II.A. The Examiner has not suggested that claims 1 or 2 of the ‘808 patent would necessarily be literally infringed if either claims 33 or 34 of the instant application were literally infringed. Claims 1 and 2 of the ‘808 patent have the closed transition phrase “consisting of”, and claims 33 and 34 of the instant application have an open-ended transition phrase ending with “comprising.” As such, applicants respectfully request withdrawal of this rejection.

**CONCLUSION**

Prompt and favorable consideration of this Amendment is respectfully requested. Should the Examiner have any questions regarding the above-identified application, he is invited to contact the undersigned at 202-942-5186.

Respectfully submitted,

A handwritten signature in black ink, reading "Kristan Lansbery". The signature is written in a cursive, flowing style.

David R. Marsh (Reg. No. 41,408)

Kristan L. Lansbery (Reg. No. 53,183)

Date: September 6, 2006

ARNOLD & PORTER LLP  
555 Twelfth Street, N.W.  
Washington, D.C. 20004-1206  
(202) 942-5000 telephone  
(202) 942-5999 facsimile